

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FRANKLIN L. GUBERNICK

---

Appeal No. 98-1047  
Application 08/612,814<sup>1</sup>

---

ON BRIEF

---

Before MEISTER, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Franklin L. Gubernick appeals from the final rejection of claims 1, 3 through 5 and 7 through 14, all of the claims pending in the application. We reverse.

---

<sup>1</sup> Application for patent filed March 11, 1996.

Appeal No. 98-1047  
Application 08/612,814

The invention relates to a spherical calendar device which is adapted to be held and squeezably deformed by a user's hand. Claim 1 is illustrative and reads as follows:

1. A deformable calendar comprising:

a deformable member that is capable of fitting in a user's hand when said member is held by a user, wherein said member is capable of assuming a spherical shape, and wherein said member has a flexible outer covering that surrounds a deformable core;

a tabular register of indicia located on an exterior surface of the covering of the deformable member, said indicia including a plurality of groupings of numbers wherein each of said groupings corresponds to a particular calendar month and wherein each of said groupings is labeled with indicia that define the calendar month associated with said grouping and wherein said indicia further includes a group of numbers that indicate a calendar year associated with the groupings of months; and

wherein the outer covering of the deformable member is made of a resilient material, and wherein a user can manually stretch a portion of said covering to thereby increase in size any of said indicia located on the surface of said stretched portion.

The references relied upon by the examiner as evidence of obviousness are:

|            |           |                |
|------------|-----------|----------------|
| Thomas     | 1,444,012 | Feb. 6, 1923   |
| Scatterday | 5,350,342 | Sept. 27, 1994 |

Claims 1, 3 through 5 and 7 through 14 stand rejected

Appeal No. 98-1047  
Application 08/612,814

under 35 U.S.C. § 103 as being unpatentable over Scatterday in view of Thomas.

Reference is made to the appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Scatterday, the examiner's primary reference, discloses "a ball-like grip that the user holds within one hand" (column 1, lines 55 and 56). As described in the reference,

[t]he user applies pressure to the grip with his or her fingers to deform the grip's shape. The grip has a structure that makes it semi-resilient in that when the user stops applying pressure to the grip after it has been significantly deformed, it only partially returns to the shape it had prior to the deformation.

To achieve this semi-resilient characteristic, the grip employs a particulate core surrounded by a resilient rubber covering. The core is comprised of a quantity of free particles intermixed with a dry lubricant powder. The lubricant allows the particles to slide over one another without damage and helps to reduce the internal resistance to sliding movement within the core.

The rubber covering exterior to the core is made of a latex rubber material that has a round shape

Appeal No. 98-1047  
Application 08/612,814

when in an undeformed state [column 1, line 56,  
through column 2, line 3].

As conceded by the examiner (see page 4 in the answer), Scatterday does not teach, and would not have suggested, a device meeting the limitations in independent claims 1 and 8 relating to

the tabular register of calendar indicia on the exterior surface of the deformable member covering. In this regard, the Scatterday device is not disclosed as having any sort of indicia.

Thomas discloses a novelty device for use as a calendar, a paper weight and/or a desk ornament. The device consists of a circular frame 10 mounted on a standard 11 rising from a base 12, and a spherical member 13 which "is provided upon its outer surface with suitable indicia representing the months and the days of the month so as to provide a calendar" (page 1, lines 49 through 52). The spherical member is rotatable within the frame so that the indicia representing each month may be moved into a display position (see Figure 1).

According to the examiner, it would have been obvious to one of ordinary skill in the art to "construct the ball-like deformable grip taught by Scatterday with indicia printed on the exterior surface as taught by Thomas as an alternate medium in which to have calendar indicia disposed and a means of providing expandable or stretchable indicia" (answer, page 4). To support this conclusion, the examiner takes official notice that it is old and well known in the art to place indicia on the exterior

surface of an elastic balloon or ball and that the indicia will deform or stretch as the underlying surface deforms and stretches (see pages 4 through 6 in the answer).

We agree with the appellant, however, that Scatterday, Thomas and the prior art knowledge officially noticed by the examiner would not have suggested the deformable calendar recited in independent claims 1 and 8.

As indicated above, Scatterday's deformable, ball-like grip does not include any indicia, much less the tabular register of calendar indicia required by claims 1 and 8. The

Appeal No. 98-1047  
Application 08/612,814

Thomas device has little, if any, relevance to the Scatterday grip and would not have furnished the artisan with any suggestion or motivation to provide the grip with calendar or any other type of indicia. This deficiency in the examiner's reference evidence finds no cure in the officially noticed general knowledge that balls and balloons may bear indicia.

We are therefore left to conclude that the examiner has engaged in an impermissible hindsight reconstruction of the appellant's invention by using the appealed claims as a template to selectively piece together isolated disclosures in the prior

art. This being the case, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 1 and 8 or of claims 3 through 5, 7 and 9 through 14 which depend therefrom.<sup>2</sup>

The decision of the examiner is reversed.

REVERSED

---

<sup>2</sup> Claims 5 and 7 are duplicates, a circumstance which should be handled in accordance with the provisions of MPEP § 706.03(k) upon return of the application to the examiner.

Appeal No. 98-1047  
Application 08/612,814

|                             |   |                 |
|-----------------------------|---|-----------------|
| JAMES M. MEISTER            | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| CHARLES E. FRANKFORT        | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| JOHN P. McQUADE             | ) |                 |
| Administrative Patent Judge | ) |                 |

Appeal No. 98-1047  
Application 08/612,814

Franklin L. Gubernick  
2540 N. Rising Star Trail  
Tucson, AZ 85745

JPM/ki